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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,422	10/15/2001	Richard J. Fask	16850-00007	4390

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EXAMINER

HYLTON, ROBIN ANNETTE

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,422

Applicant(s)

FASK ET AL.

Examiner

Robin A. Hylton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the membrane of the plug must be shown in figure 2B (claim 1) or the feature canceled from the claims. No new matter should be entered.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should contain at least one technical, or inventive, feature of the claimed instant invention.

Claim Rejections - 35 USC § 112

3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "improved" is redundant and unnecessary, at best, since an invention is either new or an improvement of an existing apparatus. The term should be removed from the claims.

The punctuation and language of the claims is somewhat confusing. For instance, see claims 1, line, 5 and claim 25, lines 5-8. Why is there a comma following, "a lid", and "said opening," and "said lid,"? Does the bore extend through the conduit or the lid? Applicant is requested to review all of the pending claims and remove such ambiguity.

Dependent claims not specifically mentioned above are rejected as being dependent upon rejected base claims since they inherently contain the same deficiencies therein.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,904,677. Although the conflicting claims are not identical, they are not patentably distinct from each other because each teaches a specimen container comprising a receptacle and a lid, the lid having a bore and a self-resealable membrane covering the bore. The patent claim further teaches the lid has screw threads and an over cover removably covering the membrane, while the claim of the instant invention is silent regarding engagement structure. It would have been obvious to one of ordinary skill in the art at the time the invention was made to set forth the lid of the instant

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invention to set forth screw threads as an old and well known structure utilized to engage a lid to a receptacle.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,11,17,18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brennan et al. (US 3,709,395).

7. Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al. (US 2,689,562).

The lid 28 comprises a first and second bore, each having a plug comprising a membrane 33 seated therein.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan in view of Schrooten (US 4,872,572).

Brennan teaches the claimed container except for the upper shoulder having a diameter greater than the lower shoulder.

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Schrooten teaches it is known to provide an upper shoulder 2a and a lower shoulder 17 on a stopper, the upper shoulder having a great diameter than the lower shoulder.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of the upper shoulder having a greater diameter than the lower shoulder to the container of Brennan. Doing so provides a graspable area for easy removal of the stopper from the container aperture.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan in view of Bucheli (US 5,297,599).

Brennan teaches the claimed container except for the ridge on the top surface of the plug.

Bucheli teaches a plug comprising a ridge on the top surface.

It would have been obvious to one of ordinary skill in the art to modify the container of Brennan in view of Bucheli to provide a ridge on the top surface of the plug. Doing so provides a sealing structure to compensate for overspacing between the closure and an overcap (not shown).

10. Claims 1-3,5,6,10-12,17,18,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storar in view of Levy (US 6,030,582).

Storar teaches the claimed lid except for the plug comprising an upper and a lower shoulder.

Levy teaches a lid comprising a plug having an upper and a lower shoulder.

It would have been obvious to one of ordinary skill in the art to modify the lid of Storar in view of Levy to provide a plug having both an upper and a lower shoulder. Doing so ensures a secure engagement between the lid and the plug at the bore.

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Storar as modified teaches the claimed invention except for screw threads attaching the lid and container together. It is old and well known in the container art that screw threads for screw-threaded sealing engagement and sealing ribs for snap-on engagement are equivalent structures known in the art. Therefore, because these two fastening means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute screw threads for annular ribs.

11. Claims 1-6,10-12,16-18,20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durkee in view of Levy.

Durkee teaches the claimed lid except for the plug comprising an upper and a lower shoulder.

Levy teaches a lid comprising a plug having an upper and a lower shoulder.

It would have been obvious to one of ordinary skill in the art to modify the lid of Durkee in view of Levy to provide a plug having both an upper and a lower shoulder. Doing so ensures a secure engagement between the lid and the plug at the bore.

Durkee as modified discloses the claimed invention except for screw threads attaching the lid and container together. Official notice is taken that it is old and well known in the container art that screw threads are an alternative means of securing a closure to a container. Thus, one of ordinary skill in the art would have found it obvious to provide screw threads as an alternative engagement means for the frictional engagement taught by Durkee.

Allowable Subject Matter

12. Claims 7-9, 13,14, 22-24 appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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13. Claims 25-29 appear to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various prior art references are cited which teach resealable closure membranes adjacent a closure opening.

15. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the examiner.

16. It is called to applicant's attention that if a communication is faxed before the reply time has expired, applicant may submit the reply with a "Certificate of Facsimile" which merely asserts that the reply is being faxed on a given date. So faxed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence for Application Serial No. _____ is being facsimiled to The U.S. Patent and Trademark Office via fax number (703) 305-3579 on the date shown below:

Typed or printed name of person signing this certificate

Signature _____

Date _____


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robin Hylton whose telephone number is (703) 308-1208. The examiner can normally be reached on Monday - Friday from 9:30 a.m. to 5:00 p.m. (Eastern time).

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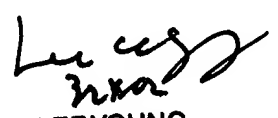
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on (703) 308-2572.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Errica Bembry at (703) 306-4005.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Robin A. Hylton 
Patent Examiner
GAU 3727

March 18, 2002


LEE YOUNG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700